

## **REMARKS**

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

The amendment filed July 28, 2008, was objected to under 35 USC § 132(a) as introducing new matter into the disclosure. In response, Applicants direct the Examiner to the second paragraph on page 8 of the amendment filed July 28, 2008. There, Applicants have explained the support for the introduced phrase “denture teeth.” The Examiner has not criticized Applicants’ explanation, nor otherwise responded in any way. Respectfully, the Examiner is required to respond to Applicants’ explanation and explain why there is no support for “denture teeth” in spite of the fact that Applicants have explained where such support can be found in the original disclosure. Applicants have explained that such support can be found, for example, in step e of original claim 1. The original claims are part of the original disclosure and, as such, material from original claims can be added to the specification without introducing new matter. *See, for example, MPEP § 608.01(l).*

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this objection. An early notice that this objection has been reconsidered and withdrawn is earnestly solicited.

Claim 18 was rejected under 35 USC § 102(e) as being anticipated by Thomas, US 7,153,135. In response, Applicants remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or

inherently described, in a single prior art reference, and, further, the absence in the prior art reference of even a single one of the claim elements is sufficient to negate anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Although claim 18 is drawn to a *device*, the Examiner has focused in the statement of the rejection on Thomas's *method* and, in so doing, has failed to account for the particular structures required by claim 18. Thus, for example, claim 18, in part (d), requires "a processing module for fitting data for *prefabricated* dental prostheses into the virtual model for creating of a virtual model with integrated dental prosthetic teeth." Applicants can find no teaching or suggestion in Thomas of such a processing module. Absent such a processing module, Applicants respectfully submit that Thomas cannot possibly anticipate claim 18.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 19, 22, 25 and 26 were rejected under 35 USC § 103(a) as being obvious over Thomas in view of Mehl, US 2006/0063135.

Claim 20 was rejected under 35 USC § 103(a) as being obvious over Thomas in view of Mehl and further in view of Baumrind, US 6,621,491.

Claim 21 was rejected under 35 USC § 103(a) as being obvious over Thomas in view of Mehl and further in view of Chishti, US 5,975,893.

Claims 23 and 24 were rejected under 35 USC § 103(a) as being obvious over Thomas in view of Mehl and further in view of Jordan et al. (“Jordan”), US 6,152,731.

In response to *all* of the obviousness rejections, Applicants respectfully submit that Mehl is not prior art to the instant application. Therefore, all of the obviousness rejections based on Thomas in view of Mehl alone or further in view of the Baumrind, Chishti and Jordan are improper and must be reconsidered and withdrawn.

In this regard, Applicants point out that under § 102(a), Mehl is prior art as of its publication date, which is March 23, 2006. Since this date is after the filing date of the instant application on February 3, 2004, Mehl does not qualify as 102(a) prior art.

Applicants note that Mehl corresponds to WO 2004/044787, which was published on May 27, 2004. However, this date is once again after the filing date of the instant application on February 3, 2004. Accordingly, again, Mehl does not qualify as 102(a) prior art.

Under 35 USC § 102(e), a PCT application that designates the United States is prior art as of its international filing date, but only if the PCT application is published in English. As noted above, Mehl corresponds to WO 2004/044787, which was published on May 27, 2004. However, WO 2004/044787 was published in German. Accordingly, Mehl does not qualify as 102(e) prior art either.

In short, Mehl is not prior art against the present application, and no obviousness rejection of the instant claims can be properly based on Mehl. Therefore, Applicants

respectfully submit that the Examiner must reconsider and withdraw all of the obviousness rejections based on Thomas in view of Mehl alone or further in view of the Baumrind, Chishti and Jordan. An early notice that these obviousness rejections have all been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
NORRIS MC LAUGHLIN & MARCUS, P.A.

By /Kurt G. Briscoe/  
Kurt G. Briscoe  
Attorney for Applicant(s)  
Reg. No. 33,141  
875 Third Avenue - 18<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844